

Notice of Allowability

Application No.

10/615,126

Applicant(s)

CHANTIGNY ET AL.

Examiner

Nyeemah Grazier

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to January 4, 2006.
2. ☒ The allowed claim(s) is/are 1-62, 64 and 67.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION
NOTICE OF ALLOWANCE

I. ACTION SUMMARY

The Amendments to the Claims and Remarks submitted to the Office on January 4, 2006 has been fully considered and will be the basis of the following Notice of Allowance.

Claims 1-67 are currently pending. Claims: 8-15, 18-20, 23-34, 41, 42, 46, 48, 53-57, previously withdrawn, have been rejoined and fully examined for patentability pursuant to M.P.E.P. § 803.02. Claims 63 and 65 are cancelled. Claim 67 has been newly added.

II. RESPONSE TO AMENDMENTS

A. Restriction/Election:

Election: Applicant's arguments with respect to specie election and request to extend the search under M.P.E.P. 803.02 has been fully considered and is persuasive. (See, Remarks, filed January 4, 2006, p. 20). The request to extend the search is **granted**. Thus, the search was extended to include all the compounds of claim 1. Claims 8-15, 18-20, 23-34, 41, 42, 46, 48, 53-57, previously withdrawn, have been rejoined and fully examined for patentability pursuant to M.P.E.P. § 803.02.

Rejoinder: Applicant's request to rejoin non-elected subject matter of claims 63 and 65 has been fully considered. (See, Remarks, filed January 4, 2006, p. 20). However, the issue is **moot** because claims 63 and 65 are cancelled without prejudice. Applicant's have

the right to file a divisional application regarding the non-elected invention of claims 63 and 65.

Claim Rejections: Applicant's arguments with respect to claim rejections of claims 1-7, 16, 17, 21, 22, 35-40, 44, 45, 47, 49-52, 58, 60-62, 64 and 66 as being anticipated by *Chen et al.* and claims 1-7, 35, 37, 47, 49-52, 58, 60, 62, 64 and 66 as being anticipated by *Dow et al.* has been fully considered and is persuasive. (*See*, Remarks, filed January 4, 2006, pp. 20-21). The rejections are **withdrawn**.

Claim Objections: Applicant's arguments with respect to claim rejections of claims 17, 21, 22, 35-40, 43-45, 47, 49-52, 58-61 have been full considered and has been obviated by the amendments to the claims. Objection of claims 17, 21, 22, 35-40, 43-45, 47, 49-52, 58-61 for improper multiple dependent claims have been **withdrawn**.

III. **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Brandon Boss, Esquire on March 22, 2006.

The application has been amended as follows:

Art Unit: 1626

1. Cancel claims 63, 65 and 66
2. In Claim 56: **delete** “and” and **insert** ---or--- after “claims 1, 4, 5, 6,” and before “7, wherein” on page 16 of 22.
3. In Claim 57: **delete** “and” and **insert** ---or--- after “claims 1, 4, 5, 6,” and before “7, wherein” on page 16 of 22.
4. In Claim 67: **delete** “and” and **insert** ---or--- after “claims 1, 4, 5, 6,” and before “7, wherein” on page 19 of 22.
5. In Claim 64: **delete** “for treating a disorder selected from the group consisting of inflammatory disorders, endocrine disorders; collagen diseases; dermatologic disease; allergic states; ophthalmic diseases; respiratory diseases; hematologic disorders; neoplastic diseases; edematous states; and gastrointestinal diseases in a mammal” after “composition” and before “comprising” on p. 18 of 22.
6. In Claim 64: **delete** “or prodrug thereof” before “or a salt” and after “and a pharmaceutically” on p. 18 of 22.

IV. REASONS FOR ALLOWANCE

The following is an examiner’s statement of reasons for allowance: The instant invention is drawn to the compound of formula (I), phenanthrene derivatives. The instant invention appears to be free of the art of record. The closest prior art reference of record is Chen et al., EP 1097709 A2. The instant invention is neither anticipated nor rendered obvious by the prior art of record because the instant invention of formula (I) R⁴ is either –OH or NR¹⁴R¹⁵. Although the

Art Unit: 1626

claimed subgenus is encompassed by the prior art genus the reference does not suggest the instant invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

V. CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:30 a.m. - 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1626

Very truly yours,



Nyeemah Grazier, Esq.

Patent Examiner, Art Unit 1626

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